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HL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/841,847    05/05/97    SCHUTT    E    ALLIA.62FIC3

HM12/0708

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EXAMINER

HOLLINDEN, G

ART UNIT

PAPER NUMBER

1616

12

DATE MAILED:

07/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/841,847**

Applicant(s)  
**Schutt et al.**

Examiner  
**Gary E. Hollinden**

Group Art Unit  
**1616**



☒ Responsive to communication(s) filed on 12/22/98; 6/23/98; 3/15/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 62, 66-76, 79-91, 94-126, 128, and 131-154 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 62, 66-76, 79-91, 94-126, 128, and 131-154 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 12

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit 1616

This Office Action is a response to the amendment filed on December 22, 1998 wherein claims 63-65, 77, 78, 82, 93, 127, 129, and 130 were canceled and claims 62, 66, 67, 79, 80, 85, 94, 95, 102, 123, and 128 were amended. The preliminary amendment filed on June 23, 1998 was also entered prior to this Office Action. Currently, Claims 62, 66-76, 79-91, 94-126, 128, and 131-154 are pending in this application and will be examined on their merits.

The Information Disclosure Statement received on March 15, 1999 has been entered and was fully considered in this Office Action.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 62, 66-76, 79-91, 94-126, 128, and 131-154 are rejected under 35 U.S.C. § 103 as being unpatentable over Lambert et al. (5,552,133), Quay (5,573,751), and Schneider et al. (5,413,774)<sup>1</sup> for reasons of record stated in the Office Action dated June 23, 1998.

Applicant's arguments filed on December 22, 1998 have been fully considered but they are not deemed to be persuasive for the following reasons:

1) Examiner concurs that the effective priority date of the Unger Patent for the use of gas mixtures that contain an insoluble gas is later than the instant effective priority date.

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<sup>1</sup>Applicant's arguments concerning Unger (5,705,187) and Yan et al. (5,556,610) were considered persuasive. Therefore, said references are withdrawn from the rejection.

2) Examiner concurs that those portions of Yan et al. which are not cumulative to Schneider et al. do not have a sufficient priority date.

3) Applicant asserts that Schneider et al. teach away from the instant invention because the specification at one point states that it is desirable to extensively purge the reaction chamber with the second gas. However, prior art must be read for all that it fairly teaches,<sup>2</sup> not simply those teachings which support Applicant's position. Applicant's attention is drawn to column 5, lines 42-47 where Schneider et al. state that the gas exchange is continued until it is more or less complete. Such language clearly allows for incomplete exchange which would mean that the gas within the microbubbles is a mixture. Applicant's contention that the present invention distinguishes over Schneider et al. because the instant invention utilizes the two gases in metered amounts does not appear to be based on the instant (independent) claims since they do not have any such limitation.

4) Applicant asserts that Schneider et al. fails to teach the osmotic stabilization set forth in the instant claims; however, since Schneider et al. teach the same compositions their microbubbles would, in fact, possess the same properties, whether or not they called the gases by the same names as the instant reference. Examiner concurs that Schneider et al. does not teach insoluble gases that would be a liquid at body temperature.

5) Applicant asserts that the pending claims require two specifically selected gases and cites case law<sup>3</sup> to support the proposition that a genus cannot render obvious a particular species where the prior art provides no motivation for selecting that species. However, said cases are not on point. In Baird, for example, the claims were directed to a single species (i.e. a single compound). The instant claims are directed to combining two broad genera together. Lambert specifically lists only 9 gases, 4 of which are non-fluorocarbon gases and the remaining 5 are fluorinated. Thus, if the ordinary artisan were to decide to follow Lambert et al.'s

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<sup>2</sup>In re Geisler, 43 USPQ 2d 1362, CA FC 1997; In re Lamberti, 192 USPQ 278, CCPA, 1976.

<sup>3</sup>In re Baird, 29 USPQ 2d 1550, CA FC 1994; In re Jones, 21 USPQ 2d 1941, CA FC 1992.

teaching to combine gases and randomly picked two gases to use, the artisan would have an approximately 50% chance of arriving at a gas mixture which would be encompassed by the instant claims. Thus, it does not appear that a great deal of picking and choosing<sup>4</sup> would be required to arrive at Applicant's invention.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. § 103. Therefore, the rejection is adhered to.

In view of the objections /rejections to the pending claims set forth above, no claims may be allowed at this time.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at 703/308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15 1989.

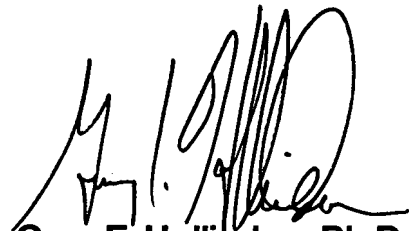
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<sup>4</sup>with the then required motivation to do so.

Art Unit 1616

Any inquiry concerning this Office Action or any earlier Office Actions in this application should be directed to Dr. Gary E. Hollinden whose telephone number is 703/308-4521. Dr. Hollinden's office hours are from 6:30 am to 3:00 pm, Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703/308-1235.

A handwritten signature in black ink, appearing to read 'G. E. Hollinden', with a stylized flourish at the end.

Gary E. Hollinden, Ph.D.

Primary Examiner

Group 1616